

REMARKS

The Examiner has taken the position that the Declaration is defective because it does not include the signature of Cynthia M. Merkin. A Declaration (copy enclosed) was indeed filed with the original application, as acknowledged by the USPTO postcard (copy also enclosed), bearing the signatures of each inventor including Cynthia M. Merkin.

Claims 12-16, 29-33, 45 and 46 are objected to as being improperly dependant. This objection is overcome in view of the amendments to claims 12-16, 29-33, 45 and 46.

Claims 1-4, 6, 7, 21-24, 25, 27, 35-41, 49, 55, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al., (U.S. 6,182,048) in view of Bakoglu et al., (U.S. 5,983,369). Claims 8, 11, 13-17, 20, 28, 31-34, 42, 45-48, 50, 51 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Olarig et al (U.S. 6,032,257). Claims 5, 9, 10, 26, 29, 30, 43, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al (U.S. Pub. 2001/0051884). Claims 18, 19 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Olarig and further in view of Wallis et al (U.S. Pub. 2001/0051884). These rejections are not applicable to the amended claims.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach receiving, by a warranty processor, a warranty upgrade request from the computer system, the warranty upgrade request including configuration information for the computer system; determining, by the warranty processor, a warranty upgrade price dependent on the configuration information in the warranty upgrade request; and paying a warranty upgrade fee to prompt release of further warranty information.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches or suggests receiving, by a warranty processor, a warranty upgrade request from the computer system, the warranty upgrade request including configuration information for the computer system; determining, by the warranty processor, a warranty upgrade price dependent on the configuration information in the warranty upgrade request; and paying a warranty upgrade fee to prompt release of further warranty information.

Thus, none of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1-38 and 41-57 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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on	<u>Apr 4, 2006</u>
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